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EXAMINER

LE, DUY K

ART UNIT PAPER NUMBER

2685

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,004

Applicant(s)

AVERKAMP, JOSEPH

Examiner

Duy K Le

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 26 and 27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 14 and 23 is/are allowed.
6) ☒ Claim(s) 1-13, 15-22, 24 is/are rejected.
7) ☒ Claim(s) 1, 26 and 27 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 2685

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: "generates a second directive indicative of the first action" should be corrected to -generates a second directive indicative of the second action-. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-7, 10, 13, 15-16, 19, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,377,825 to Kennedy et al. in view of Rubbmark et al. (U.S. Patent 6,549,790).

As to claim 1 (currently amended), Figures 1A, 1B, 3, 4A, and 4B in Kennedy clearly show a control system that is coupled externally to a subscriber terminal, the subscriber terminal having a status, the control system comprising, in combination:

an actuator 142 that can be selectively actuated by a human;
a controller 320 receiving an actuation signal in response to actuation of the actuator;
a routine performed by the controller for (i) determining, based at least on the actuation signal and status of the subscriber terminal, an action to be taken by the subscriber terminal ("where a telephone call is not in progress (i.e., the telephone 102 is on-hook), a user may

Art Unit: 2685

command that a general voice recognition mode be entered" (Col. 19, lines 13-15).

"Alternatively, the user may press a button 142a provided on the exterior of the pocket 104b to place the system 100 in voice recognition mode" (Col. 19, lines 16-22)), (ii) generating a directive indicative of the action, and (iii) sending the directive to the subscriber terminal ("thus when the command "call home" is received, a signal to initiate a telephone call will be formatted in the API of the system 100, and passed to the microprocessor 320 of pocket A2 104b, where the API command is translated into a signal understood by the telephone 102. Where the telephone number associated with "home" is stored in memory 324 or 340, the command to the telephone 102 may consist of the digits of the telephone number and the send command" (Col. 19, lines 44-52). The subscriber terminal may then take the action in response to the directive and in the description above, dials a telephone number).

wherein, if the status is a first status, then the controller determines a first action to be taken by the subscriber terminal, generates a first directive indicative of the first action, and sends a first directive to the subscriber terminal (see Col. 19, lines 11-23. "first status" is that a telephone call is not in progress (i.e., the telephone 102 is on-hook); "first action" and "first directive" is to enter voice recognition mode);

wherein, if the status is a second status, then the controller determines a second action to be taken by the subscriber terminal, generates a second directive indicative of the second action, and sends a second directive to the subscriber terminal (see Col. 19, lines 11-23. "second status" is that a telephone call is in progress (i.e., the telephone 102 is off-hook); "second action" and "second directive" is to enter voice recognition mode); and

wherein the first status is different than the second status (see Col. 19, lines 11-23 and above paragraphs).

However, the Kennedy reference does not disclose the first action is different than the second action, and the first directive is different than the second directive. The Rubbmark reference teaches the first action is different than the second action, and the first directive is different than the second directive (see Col. 2, lines 58-62, Col. 3, lines 24-26, Col. 6, lines 51-63 (“first status”: incoming call; “first action”: receive incoming call; “first directive”: hands free unit sends AT*EVA command to the mobile station), Col. 7, lines 1-12 (“second status”: ongoing call; “second action”: terminate ongoing call; “second directive”: hands free unit sends AT*EVH command to the mobile station), Col. 10, line 65 to Col. 11, line 35, and Figures 1-4).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Kennedy wherein the first action is different than the second action, and the first directive is different than the second directive, as taught by Rubbmark, in order to force each accessory to send relevant user actions to the mobile telephone and request an appropriate service from the mobile telephone.

As to claim 2 (original), Kennedy-Rubbmark discloses the control system of claim 1. Figure 3 in Kennedy further shows a microphone 368 for receiving audio signals to be provided to the subscriber terminal, whereby the audio signals may comprise speech signals (“thus, the pocket A1 104a may provide basic speaker phone functions” (Col. 15, lines 58-59). “The basic speaker phone functions may comprise the provision of a speaker 366 and microphone 368” (Col. 15, lines 60-62)).

As to claim 3 (original), Kennedy-Rubbmark discloses the control system of claim 1. Figure 3 in Kennedy further shows an audio output source 344 for providing audio signals from the subscriber terminal to the speaker 366, to be heard by a human.

As to claim 4 (currently amended), Kennedy-Rubbmark discloses the control system of claim 1. Figure 1B in Kennedy further shows an actuator 142b comprises a single button that can be actuated by the human.

As to claim 6 (original), Kennedy-Rubbmark discloses the control system of claim 1. Figure 3 in Kennedy further shows the controller comprises a processor 320, a memory 324, and a set of machine language instructions stored in the memory and executable by the processor (“specifically, the memory 324 of the pocket 104 contains code, machine language instructions, that allows the pocket 104 to translate between commands formatted in the API of the system 100 and the proprietary communications interface of the telephone 102” (Col. 14, lines 38-42)); and the machine language instructions define the routine (see Col. 14, lines 38-42).

As to claim 7 (original), Kennedy-Rubbmark discloses the control system of claim 1, wherein the subscriber terminal defines a plurality of functions (as cited in claim 1 and in Kennedy, the subscriber terminal can dial a telephone number as an action in response to a directive from the controller. In addition, “by pressing the associated buttons 142b, or by issuing the appropriate voice command, such as “take a memo”, the system 100 may be configured to record a voice message” (Col. 19, lines 61-63)) and wherein the action comprises the subscriber terminal carrying out one or more of those functions in the subscriber terminal (see Col. 19, lines 61-63. The plurality of functions include dialing a telephone number and taking a voice memo).

As to claims 10 and 19 (original), Kennedy-Rubbmark discloses a control system of claim 1 and the method of claim 16, wherein, if the subscriber terminal is on and engaged in a call, then the action comprises the subscriber terminal terminating the call (Rubbmark: see Col. 7, lines 1-12).

As to claims 13 and 22 (original), Kennedy-Rubbmark discloses a control system of claim 1 and the method of claim 16, wherein, if the subscriber terminal is on and receiving an incoming call, then the action comprises the subscriber terminal connecting to the call (Rubbmark: see Col. 6, lines 51-63).

As to claims 15 and 24 (original), Kennedy-Rubbmark discloses the control system of claim 1 and the method of claim 16, wherein the subscriber terminal is a wireless subscriber terminal (Kennedy; "the telephone 102 can be a wireless communications device").

As to claim 16 (currently amended), as cited in claim 1 for a control system, Kennedy-Rubbmark discloses a method for controlling communications of a subscriber terminal as recited in claim 16.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,377,825 to Kennedy et al. in view of Rubbmark et al. (U.S. Patent 6,549,790) and further in view of Kunihiro et al. (U.S. Patent 5,915,228).

As to claim 5 (original), Kennedy-Rubbmark discloses the control system of claim 1. However, it does not disclose the actuator comprises a single rotary dial. Figure 1B in Kunihiro clearly shows and teaches a rotary dial as an actuator. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hands-free

Art Unit: 2685

communication device of Kennedy wherein the actuator comprises a single rotary dial, as taught by Kunihiro, in order to allow a user to easily actuate many operations with a single dial.

5. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,377,825 to Kennedy et al. in view of Rubbmark et al. (U.S. Patent 6,549,790) and further in view of Kravitz (U.S. Patent 6,035,217).

As to claims 8 and 17 (original), Kennedy-Rubbmark discloses a control system of claim 1 and the method of claim 16, wherein, if the subscriber terminal is on and idle, then the action comprises the subscriber terminal dialing one or more digits suitable for establishing a dial-up connection (Rubbmark: see Col. 7, line 65 to Col. 8, line 4 and Figure 3). However, Kennedy-Rubbmark does not disclose dialing to establish a dial-up connection to a voice-activated-dialing platform and whereby, once the subscriber terminal is connected to the voice-activated-dialing platform, a human may speak into a microphone so as to provide speech signals that may be recognized and acted upon by the voice-activated-dialing platform.

The Kravitz reference teaches dialing to establish a dial-up connection to a voice-activated-dialing platform and whereby, once the subscriber terminal is connected to the voice-activated-dialing platform, a human may speak into a microphone so as to provide speech signals that may be recognized and acted upon by the voice-activated-dialing platform (Figure 6 in Kravitz clearly shows the steps for user to make a call using a voice-activated-dialing platform. The user presses a single button to dial a service provider that can be an automatic voice-recognition device. "After the user is connected with the service provider, the user communicates a desired number to the service provider by speaking the number to be called into the

microphone 214 of the one button cellular phone 100” (Col. 5, lines 19-22). The service provider then “dials the requested number” (Col. 5, line 28)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hands-free communication device of Kennedy-Rubbmark to dial to establish a dial-up connection to a voice-activated-dialing platform and whereby, once the subscriber terminal is connected to the voice-activated-dialing platform, a human may speak into a microphone so as to provide speech signals that may be recognized and acted upon by the voice-activated-dialing platform. One would have been motivated to make such a modification in view of the suggestion in Kravitz to allow users to make telephone call without having to key in a telephone number and thus alleviate the problem and danger when the user is using a wireless phone while driving a car and having to hold the telephone in one hand and operate the car with the other hand.

6. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,377,825 to Kennedy et al. in view of Rubbmark et al. (U.S. Patent 6,549,790) in view of Kravitz (U.S. Patent 6,035,217) and further in view of Kirbas et al. (U.S. Patent 6,449,497).

As to claims 9 and 18 (original), Kennedy-Rubbmark-Kravitz discloses the control system of claim 8 and the method of claim 17. However, it does not disclose the one or more digits are selected from the group consisting of (i) a feature code and (ii) a telephone number.

The Kirbas reference teaches the one or more digits are selected from the group consisting of (i) a feature code and (ii) a telephone number (Figure 4 in Kirbas shows a complete destination telephone number with a feature code pre-pended. “The partial destination telephone

number is supplemented by adding feature codes to generate a complete destination telephone number” (Col. 4, lines 54-57)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system and method of Kennedy-Rubbmark-Kravitz to have the subscriber terminal dialing one or more digits from the group consisting of (i) a feature code and (ii) a telephone number. One would have been motivated to make such a modification in view of the suggestion in Kirbas to speed-dial a telephone number by not having to key in all the digits of the telephone number.

7. Claims 11-12 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,377,825 to Kennedy et al. in view of Rubbmark et al. (U.S. Patent 6,549,790) and further in view of Maloney (U.S. Patent 6,453,169).

As to claims 11 and 20 (original), Kennedy-Rubbmark discloses the control system of claim 10 and the method of claim 19, wherein the controller determines the action in response to the subscriber terminal is on and engaged in a call. However, it does not disclose the actuation signal reflecting that the actuator was actuated for at least a predetermined duration.

The Maloney reference teaches the actuation signal reflecting that the actuator was actuated for at least a predetermined duration (Figure 9 in Maloney shows a determination of duration of power key depression for the subscriber terminal to take an action. “The communication device comprises at least a power key, and a control circuit, coupled to the power key, for sensing an actuation of the power key, and for silencing an alert in response to the actuation of the power key if a duration of the actuation is greater than a first predetermined time period” (Col. 2, lines 41-47)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system and method of Kennedy-Rubbmark wherein the controller determines the action in response to the actuation signal reflecting that the actuator was actuated for at least a predetermined duration, as taught by Maloney in order to prevent accidental press of the actuator terminating a call.

As to claims 12 and 21 (original), Kennedy-Rubbmark-Maloney discloses the control system of claim 11 and the method of claim 20, wherein the predetermined duration is 1.5 seconds (the predetermined duration T1 as denoted in Figure 9 in Maloney can be any duration sufficiently long, such as 1.5 seconds, in order for the controller to know and ignore short duration depression of the actuator so as to prevent accidental press of the actuator terminating a call).

Allowable Subject Matter

8. The currently amended claims 14 and 23 are allowed.

The prior art of record fails to show or fairly suggest a system and method, wherein, if the subscriber terminal is on and engaged in call placed via a voice-activated dialing platform, then with the actuation of the actuator, the subscriber terminal instructs the voice-activated dialing platform to disconnect the call but to retain a connection between the voice-activated dialing platform and the subscriber terminal so that the subscriber terminal can make another call via the voice-activated dialing platform, in combination with other features cited in the claims.

9. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to show or fairly suggest a system and method, wherein, if the subscriber terminal is on and engaged in call placed via a voice-activated dialing platform, then with the actuation of the actuator, the subscriber terminal instructs the voice-activated dialing platform to disconnect the call but to retain a connection between the voice-activated dialing platform and the subscriber terminal so that the subscriber terminal can make another call via the voice-activated dialing platform.

Response to Arguments

10. Applicant's arguments with respect to claims 1 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Paterson et al. (U.S. Patent 5,794,163) discloses headset for hands-free wireless telephone.
- b. Tendler (U.S. Patent 6,519,463) discloses location based service request system.

Art Unit: 2685

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy K Le whose telephone number is 703-305-5660. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Duy Le
June 30, 2004

 7/12/04

QUOCHIEN B. VUONG
PRIMARY EXAMINER